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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,720	02/19/2004	Jack T. Oldham	1684-6036US (484-28684-US)	7639
24247	7590	12/13/2007	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3676	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

## Office Action Summary

Application No.

10/783,720

Applicant(s)

OLDHAM ET AL.

Examiner

Shane Bomar

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-74, 179-186 and 189-193 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11-74, 179-186, 189, 190, 192 and 193 is/are allowed.
- 6) ☒ Claim(s) 191 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/30/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. The Request for Continued Examination filed October 31, 2007 is improper because prosecution wasn't closed (i.e., the last office action was non-final). MPEP 706.07(h) says the following:

**1. Prosecution Is Not Closed**

If prosecution in the application is not closed, applicant will be notified of the improper RCE and any amendment/reply will be entered. Thereafter, the application will be forwarded to the examiner for consideration of the amendment/reply under 37 CFR 1.111.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claim 191 is rejected under 35 U.S.C. 102(a) as being anticipated by paper # WOCD-0306-05 to McKay et al (paper #1).

Paper #1 discloses three types of casing bits, the DS 1, DS 2, and DS 3, wherein each bit has an inner profile, an outer profile, and a nose portion; at least one aperture formed in the nose portion of the casing bit and configured for delivering drilling fluid from an interior of the casing bit to an exterior thereof; a plurality of generally radially extending blades, or discrete cutting element retention structures, disposed on the nose portion, wherein at least one of the plurality of blades carries one or more cutting elements affixed thereto; and at least one gage section, the at

least one gage section extending longitudinally from adjacent the nose portion of the casing bit (see Figs. 1-3, the Introduction, and the Background).

Regarding claim 191, Figures 1 and 2 of paper #1, show grooves behind and between the cutting elements on the blades. These grooves would inherently cause the bit face to break into two or more smaller sections when the next drill bit drills through the first bit.

***Allowable Subject Matter***

4. Claims 1-9, 11-74, 179-186, 189, 190, 192, and 193 are allowed.

***Response to Arguments***

5. Applicant's arguments filed September 18, 2007 with respect to claim 191 have been fully considered but they are not persuasive. The Applicant argues that it is not inherent that the grooves between adjacent cutting elements on the blade will cause the blade to separate into two or more smaller sections. However, it is clear to one of ordinary skill in the art that when the subsequent drilling tool reaches at least two adjacent cutting elements, there being a groove, or valley, between each cutting element, that the two cutting elements, which are part of the blade, will separate into two smaller sections. In fact, it is clear that most of the top portions of the cutting elements will be released from the blades as the subsequent drilling tool penetrates the first drilling tool due to the grooves between the cutting elements. If there were no grooves between each cutting element, then this assertion would clearly not be based on inherency. Yet, with the presence of the grooves, it is clear and inherent that such separation of the blades (again, the cutting elements are integral to the blades) will occur.

6. Applicant's arguments, see pages 21, 22, and 24-30, with respect to claims 179, 180, 189, and 193 have been fully considered and are persuasive. The rejection of said claims, and any dependent claims, has been withdrawn.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

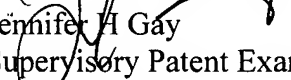
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In USA or Canada) or 571-272-1000.



Jennifer H Gay  
Supervisory Patent Examiner  
Art Unit 3676

December 5, 2007

tsb